

REMARKS

Claims 1-20 are pending in the above-captioned patent application. Claims 5, 8, 11, 16, and 19 were withdrawn in the Response to Election of Species Requirement electronically filed on October 5, 2006 and remain withdrawn.

The examiner rejected claims 1-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The reasoning for the examiner's rejection is that the specification, as filed, did not contain the words "no part of the image-carrying sheet is situated in the disk-like portion" and that, in the examiner's view, the drawings cannot be relied upon for this limitation. The examiner's reasoning is unfounded and is contrary to well established case law, such as that mentioned in M.P.E.P § 2163, which is titled "Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, 'Written Description' Requirement." A relevant excerpt from section II.3.(a) of M.P.E.P. § 2163 is reproduced as follows for the examiner's convenience:

An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. See, e.g., Vas-Cath, 935 F.2d at 1565, 19 USPQ2d at 1118 ("**drawings alone may provide a 'written description' of an invention** as required by Sec. 112*"); In re Wolfensperger, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) (the drawings of applicant's specification provided sufficient written descriptive support for the claim limitation at issue); Autogiro Co. of America v. United States, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967) ("In those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.") (Emphasis added)

The drawings of the present application clearly demonstrate that applicant is in possession of the portions of the independent claims which the examiner, erroneously, finds objectionable. Specifically, the drawings of the present application clearly demonstrate that applicant is in possession of the claim phrase "no part of the image-carrying sheet is situated in the disk-like portion" appearing in independent claim 1, the claim phrase "no part of the image-

carrying sheet is situated in the horizontal disk-like portion of the plastic-receiving space” appearing in independent claim 9, and the claim phrase “no part of the image-carrying sheet is situated in the lower disk-like portion of the plastic-receiving space” appearing in independent claim 17. See Figs. 11 and 15 with regard to applicant’s elected species of Figs. 9-15. Figs. 3, 7, 8, 18, and 21 similarly demonstrate applicants possession of the portions of the independent claims that the examiner finds objectionable with regard to the non-elected species.

Accordingly, applicant is in compliance with the written description requirement and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph is respectfully requested.

The examiner rejected claims 1-3, 9 and 10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,193,711 to Hirata et al. (hereinafter “Hirata”). This is a curious rejection because the examiner admits in the last two lines of page 2 of the October 9, 2007 Office Action that “. . . applicant has amended the claims in a manner to ‘get around’ Hirata et al. . . .” Because the claims have been so amended, as the examiner admits, it naturally follows that each of the claims mentioned in the examiner’s 102(b) rejection contains at least one recitation that cannot be found in Hirata. Accordingly, Hirata cannot properly be considered to anticipate any of claims 1-3, 9 and 10 under 35 U.S.C. § 102(b). Thus, withdrawal of the rejection of claims 1-3, 9 and 10 under 35 U.S.C. § 102(b) as being anticipated by Hirata is respectfully requested.

The examiner rejected claims 1-5, 8-11, and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over Hirata based on obviousness. According to MPEP § 2143.03, which has the heading “All Claim Limitations Must Be Taught or Suggested,” “[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art**. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” (Emphasis added) As mentioned above, the examiner already conceded that “. . . applicant has amended the claims in a manner to ‘get around’ Hirata et al. . . .” Accordingly, because the single Hirata reference that the examiner relies upon in making the 103(a) rejection does not teach or suggest all of the claim limitations in any of the currently pending independent claims, the examiner has not made out a *prima facie* of obviousness based on Hirata, and therefore, the obviousness rejection should be withdrawn for at least this reason. Furthermore, while the examiner contends that it would be

obvious to modify Hirata's structure to omit Hirata's bottom sheet (which is indicated by reference numeral 5 in Hirata's various embodiments), the undersigned disagrees with this conclusion because Hirata seems to teach away from such arrangements. See the discussion at col. 1, line 60 through col. 2, line 7 of Hirata, and at col. 4, lines 24-30 of Hirata, regarding Hirata's Figs. 21(A) PRIOR ART and 21(B) PRIOR ART, in which Hirata actually denigrates prior art structures that lack a bottom sheet due to the ability of the molded plastic to reach the outer side of the label. Hirata even recognized that some prior art arrangements, such as that shown in Hirata's Fig. 20 PRIOR ART, included a bottom sheet but denigrated that prior art embodiment at col. 1, lines 54-59 as having "to be relatively thick to accommodate the joining process, with a result of an increased cost." Hirata goes on to state, at col. 2, lines 42-51, "[a]n important feature of the invention lies in that the label comprising the bottom wall section and the side wall sections is formed into the respective side wall sections which extend from the respective boundaries between the side and bottom wall sections along extensions of the opposite side edges of the bottom wall section and these cuts are utilized to fold the side wall sections upward with respect to the bottom wall section so as to facilitate a smooth flow of injected resin in the proximities of said boundaries." Thus, not only does each of Hirata's embodiments have a bottom wall section 5, Hirata states that having such a bottom wall section is "important." With this emphasis in Hirata on the importance of the bottom wall section, coupled with the denigration of prior art in-molded labels that lacked a bottom wall altogether, it is not seen how the examiner can properly conclude that it would have been obvious to one skilled in the art to remove Hirata's bottom wall section 5. For this additional reason, it is respectfully requested that the examiner withdraw the rejection of claims 1-5, 8-11, and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over Hirata.

For the reasons mentioned above, claims 1-20 are believed to be in condition for allowance and such action is respectfully requested. In the event that there are any questions related to this paper or to the application in general, the Examiner is invited to call the undersigned at (317) 231-7341.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and

that shortages in fees, if any, be charged to the Account of Barnes & Thornburg, Deposit Account No. 10-0435, with reference to our file 3044-73785.

Respectfully submitted,
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